

4



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,451	04/06/2001	Robert F. Terry	52723.00002	6181

7590 11/03/2004

Arnold M. DeGuzman
 DeGuzman & CARPENTER LLP
 5276 Hollister Ave.
 Suite 160
 Santan Barbara, CA 93111

EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary

Application No.

09/827,451

Applicant(s)

TERRY, ROBERT F.

Examiner

Michael Pyzocha

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2137

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a method of detecting states to detect unauthorized behavior or software, classified in class 713, subclass 188.
- II. Claims 16-17 and 21, drawn to a method of electronically mapping a hard drive, classified in class 707, subclass 204.
- III. Claim 18, drawn to monitoring messages between the operating system and an application, classified in class 719, subclass 329.
- IV. Claim 19, drawn to backing up computer registry information, classified in class 711, subclass 162.
- V. Claims 20 and 22, drawn to comparing activity states between current and stored states to determine differences, classified in class 714, subclass 49.
- VI. Claims 23 and 25, drawn to comparing messages to detect unauthorized activity, classified in class 714, subclass 723.

Art Unit: 2137

VII. Claim 24, drawn to detecting unauthorized activity and sending the report to a second computer, classified in class 709, subclass 224.

VIII. Claims 26-39, drawn to detecting states that are active to determine modification, classified in class 714, subclass 21.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without mapping of the hard drive as done in invention II. See MPEP § 806.05(d).

3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without monitoring operating system message as done in invention III. See MPEP § 806.05(d).

Art Unit: 2137

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without backing up the registry as done in invention IV. See MPEP § 806.05(d).

5. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without comparing current states to stored states as in invention V. See MPEP § 806.05(d).

6. Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without comparing messages as in invention VI. See MPEP § 806.05(d).

7. Inventions I and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown

Art Unit: 2137

to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without sending a report to another computer as done in invention VII. See MPEP § 806.05(d).

8. Inventions I and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as detecting unauthorized use without determining modification as done in invention VIII. See MPEP § 806.05(d).

9. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as mapping a hard drive without monitoring messages as in invention III. See MPEP § 806.05(d).

10. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as mapping a hard drive without backing up the computer registry. See MPEP § 806.05(d).

Art Unit: 2137

11. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as mapping a hard drive without comparing activity states as in invention V. See MPEP § 806.05(d).

12. Inventions II and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as mapping a hard drive without comparing messages as in invention VI. See MPEP § 806.05(d).

13. Inventions II and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as mapping a hard drive without sending a report to a second computer as in invention VII. See MPEP § 806.05(d).

14. Inventions II and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has

Art Unit: 2137

separate utility such as mapping a hard drive without detecting states to determine modification as in invention VIII. See MPEP § 806.05(d).

15. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as monitoring messages between the operating system and an application without backing up the computer registry as in invention IV. See MPEP § 806.05(d).

16. Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as monitoring messages between the operating system and an application without comparing activity states as in invention V. See MPEP § 806.05(d).

17. Inventions III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as monitoring messages between the

Art Unit: 2137

operating system and an application without comparing messages as in invention VI. See MPEP § 806.05(d).

18. Inventions III and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as monitoring messages between the operating system and an application without sending a report to a second computer as in invention VII. See MPEP § 806.05(d).

19. Inventions III and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as monitoring messages between the operating system and an application without detection states as in invention VIII. See MPEP § 806.05(d).

20. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as backing up computer registry information without comparing activity states as in invention V. See MPEP § 806.05(d).

Art Unit: 2137

21. Inventions IV and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as backing up computer registry information without comparing messages as in invention VI. See MPEP § 806.05(d).

22. Inventions IV and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as backing up computer registry information without sending a report to a second computer as in invention VII. See MPEP § 806.05(d).

23. Inventions IV and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as backing up computer registry information without detection states as in invention VIII. See MPEP § 806.05(d).

24. Inventions V and VI are related as subcombinations disclosed as usable together in a single combination. The

Art Unit: 2137

subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as comparing activity states between current and stored states to determine differences without comparing messages as in invention VI. See MPEP § 806.05(d).

25. Inventions V and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as comparing activity states between current and stored states to determine differences without sending a report to a second computer as in invention VII. See MPEP § 806.05(d).

26. Inventions V and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as comparing activity states between current and stored states to determine differences without detecting states that are active as in invention VIII. See MPEP § 806.05(d).

27. Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The

Art Unit: 2137

subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as comparing messages to detect unauthorized activity without sending a report to a second computer as in invention VII. See MPEP § 806.05(d).

28. Inventions VI and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as comparing messages to detect unauthorized activity without detection states that are active as in invention VIII. See MPEP § 806.05(d).

29. Inventions VII and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as sending a report of unauthorized activity to a second computer without detecting states that are active as in invention VIII. See MPEP § 806.05(d).

30. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2137

Conclusion

31. A shortened statutory period for response to this action is set to expire one month (not less than 30 days) from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


Andrew Caldwell